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EXAMINER

PENG, KUO LIANG

ART UNIT

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1796

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/593,623	<b>Applicant(s)</b> TRABESINGER ET AL.	
	<b>Examiner</b> Kuo-Liang Peng	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9/21/06 IDS.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)                                 |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| Paper No(s)/Mail Date <u>9/21/06</u> .   | 6) <input checked="" type="checkbox"/> Other: <u>FR 2 616 322 Machine translation</u> . |

### **DETAILED ACTION**

1. The Applicants' preliminary amendment filed December 18, 2007 is acknowledged. Claims 9, 11, 15-18, 23-27 and 30-31 are amended. Now, Claims 1-32 are pending.

### ***Specification***

2. The disclosure is objected to because of the following informalities:

In the specification (page 3, lines 16 and 32), "claim 1", "claim 18" and "claim 26" are improper.

In the specification (page 15, line 27), there is no "cutting means 8" in Figure 2a) or Figure 2b). Should it be "cutting means 7"?

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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4. Claims 18-26 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claims 1 (line 4), 4 (4<sup>th</sup> line from bottom) and 6 (line 3), “comprising” causes confusion because it is improper as a part of a Markush language.

In Claim 1 (last two lines), “the first and the second .... at least one dividing wall” causes confusion because it is not clear as to what Applicants intend to claim, i.e., a two-component adhesion promoter composition or a package, etc. For the purpose of compact prosecution, the instant claim is presumed to be directed to a composition, ***pending rectification***.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, Claim 2 recites the broad recitation “at least

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one” (line 3), and the claim also recites “in particular at least two” (line 3) which is the narrower statement of the range/limitation. In Claim 4 (lines 7, 9, 10 and last line), 5 (line 3), 6 (3<sup>rd</sup> line from bottom), 8 (line 3), 12 (lines 2, 3 and 4), 13 (lines 2 and 3), 14 (last two lines), 16 (line 3), 20 (line 3), 23 (line 3), 24 (line 2), 25 (lines 3 and 4), 26 (last line), 29 (line 4), 30 (lines 3 and 4) and 32 (last line), the terms "especially", "particularly" and/or “preferably” have similar issue.

Claims 18-26 provide for the use of a pack, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

### ***Double Patenting Rejection***

7. A rejection based on double patenting of the “same invention” type finds its support in the language of 35 U.S.C. 101 which states that “whoever invents or discovers any new and useful process... may obtain a patent therefor...” (Emphasis added). Thus, the term “same invention,” in this context, means an invention drawn to identical subject matter. See

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*Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 1-32 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-32 of copending Application No. 12/000,850. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-12 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Huang (US 6 037 008), optionally as evidenced by Brown (US 2007 0215267)

When the term “two-component” in the preamble refers to the composition comprising two components, the following rejection applies.

For Claims 1-10 and 15-17, Huang discloses a two-component aqueous primer composition comprising **alkoxysilane** such as 3-methacryloxypropyltriethoxysilane, etc. and a catalyst such as **titanium ortho ester complex** such as TYZOR GBA (a titanium alkoxide). (col. 3, lines 12-23 and col. 4, lines 15-38) For Claims 11-12, the composition can contain an organotin catalyst such as FOMREZ UL-22 that is a **dibutyltin dilaurate** as taught in Brown ([0024]) Notably, Brown is here merely to show the identity of FOMREZ UL-22.

When the term “two-component” in the preamble refers to the composition comprising two components that are physically separated (i.e., a two-part composition), the following rejection applies.



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Huang discloses an aqueous primer composition comprising **alkoxysilane** such as 3-methacryloxypropyltriethoxysilane, etc. and a catalyst such as **titanium ortho ester complex** such as TYZOR GBA (a titanium alkoxide). (col. 3, lines 12-23 and col. 4, lines 15-38) Huang is silent on the foregoing two components are a two-part composition. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to store these two components separately in order to further prolong the shelf-life thereof.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang, optionally as evidenced by Brown, and further in view of Yamaguchi (US 6 200 684).

Huang discloses a two-component aqueous primer composition comprising a catalyst such as titanium alkoxide, organotin, etc., *supra*, which is incorporated herein by reference. Huang is silent on the use of an acid. However, Yamaguchi teaches the equivalence and interchangeability among organotin, tetra-n-butyl titanate (a titanium alkoxide), sulfuric acid, acetic acid, methanesulfonic acid, etc. as a hydrolytical condensation catalyst. (col. 4, lines 17-32) Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a hydrolytical condensation catalyst such as sulfuric acid, methanesulfonic acid or acetic acid in Huang's composition with expected success.

13. Claims 18-19 and 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang, optionally as evidenced by Brown, and further in view of D'Alessio (US 6 340 097).

Huang discloses a two-component aqueous primer composition, *supra*, which is incorporated herein by reference. Huang is silent on the use of the claimed pack and a package consisting of the pack. However, D'Alessio teaches the use of a pack comprising two **crushable ampoules** each containing one of the two components. The two ampoules can be

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arranged such that one ampoule is contained in the other ampoule. The relative amounts of the two components are exemplified in Examples.

The ampoules can be made of **glass**, etc. (col. 5, lines 6-25) As such, one of ordinary skill in the art would know that separating the two components in a two-parts composition as taught in D'Alessio's package would have yielded the **PREDICTABLE** result of prolong the shelf-life of the composition. Therefore, it would have been obvious to have Huang's two components included in D'Alessio's package with expected success. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

14. Claims 18-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang, optionally as evidenced by Brown, and further in view of Jamet (FR 2 616 322).

Huang discloses a two-component aqueous primer composition, *supra*, which is incorporated herein by reference. Huang is silent on the use of the claimed pack and a package consisting of the pack. However, Jamet discloses package comprising a container having two reactive components enclosed in separate compartments divided by a breakable wall as depicted in Figure 1 so that the two reactive components are capable of

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being mixed at a desired time. As such, one of ordinary skill in the art would know that separating the two components in a two-part composition as taught in Jamet's package would have yielded the **PREDICTABLE** result of prolong the shelf-life of the composition. Therefore, it would have been obvious to have Huang's two components included in Jamet's package with expected success. *id.*

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is

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available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
May 26, 2010

/Kuo-Liang Peng/  
Primary Examiner, Art Unit 1796